

In re Patent Application of  
**BARDWELL**  
Serial No. 10/081,886  
Filed: FEBRUARY 22, 2002

REMARKS

Applicants thank the Examiner for the careful and thorough examination of the present application. By this amendment, Claim 5 has been amended to eliminate minor informalities contained therein. Claims 1-21 remain pending in the application. Favorable reconsideration is respectfully requested.

I. The Invention

As shown in FIGS. 1-6, for example, the disclosed invention is directed to a biometric identification and verification system and method including the use of biometric data and a PIN. The features of the invention are provided by a method for storing biometric information on a token having a magnetic storage medium. The method includes capturing a biometric image and generating biometric data therefrom, obtaining a personal identification number (PIN) and storing the biometric data and the PIN on the magnetic storage medium of the token.

II. The Claims are Patentable

Claims 1-21 were rejected in view of Abtahi et al. (U.S. 5,509,083) and Baratelli (U.S. 6,325,285) taken together or in combination with Lasch et al. (U.S. 6,581,839) for the reasons set forth on pages 3-5 of the Office Action. Applicant contends that Claims 1-21 clearly define over the cited references, and in view of the following remarks, favorable

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reconsideration of the rejections under 35 U.S.C. §103 is requested.

Each of the independent Claims 1, 8 and 14 includes capturing a biometric image...generating biometric data, and storing the biometric data and a PIN on a magnetic storage medium of a token/card. It is this combination of features which is not fairly taught or suggested in the cited references and which patentably defines over the cited references.

The Examiner has relied on the Abtahi et al. patent as allegedly disclosing the storing of captured fingerprint information on a magnetic stripe of a card, and that captured images are stored as a digital pixel array. Applicant maintains that the Examiner has misinterpreted the cited reference.

The Abtahi et al. patent is directed to a magnetic strip card based fingerprint verification system that utilizes a standardized fingerprint feature template library for identification purposes. The system verifies that the card user is the card owner by matching the image of the card holder's fingerprint to the unique code which has been assigned to the card owner and encoded on the card's magnetic strip and then verifying this information with records at a remote location. Referring to Fig. 1 of Abtahi et al., retrieved feature parameters 134 and other information read off the card's magnetic strip 44 and 62 are transmitted via the data communications interface 80 to a remote system to validate the name, account number and the matching fingerprint

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record, which are stored as a file for the card owner in the remote system database.

There is no teaching of storing captured fingerprint information on a magnetic stripe of a card, and that captured images are stored as a digital pixel array, as alleged by the Examiner. Indeed, Abtahi et al. does not disclose storing biometric data and/or a PIN on a magnetic stripe, as claimed.

The Examiner has also relied upon the Baratelli patent as teaching the use of a PIN and fingerprint information stored in a memory of a smart card.

More specifically, the Baratelli patent discloses a smart card including a CPU, memory, and a fingerprint reader including a sensing surface. The sensing surface is located along a surface of the smart card so that a user's thumb is naturally positioned over the sensing surface when the card is inserted into a write/read unit or other suitable card reader. When an individual inserts the smart card into a write/read unit, the smart card creates an electrical representation of the individual's fingerprint and compares the acquired representation to a stored fingerprint representation in the card's memory.

The memory in Baratelli is a semiconductor or static memory such as a RAM, ROM or EEPROM. There is no magnetic stripe in Baratelli and consequently no teaching of storing biometric data and/or a PIN on a magnetic stripe. Accordingly, nothing in Baratelli makes up for the deficiencies of the Abtahi et al. patent as noted above.

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Moreover, Applicant maintains that the Examiner is impermissibly using the teachings of Applicant's own patent application as a roadmap to modify the prior art. For example, as noted above, the method and apparatus of Abtahi et al. uses a template library at a remote location in combination with a code stored on a magnetic stripe without the use of a PIN, while the Baratelli patent is directed to a smart card having a RAM or EEPROM. The skilled artisan would clearly recognize the relative storage capacity differential between a magnetic stripe on a card versus a RAM or EEPROM of a smart card. Again, there is no disclosure or teaching of storing biometric data and/or a PIN on a magnetic stripe of a token as claimed.

Additionally, Applicant specifically traverses the Examiner's obviousness assertion regarding the Lasch et al. patent. Nothing in either the Lasch et al. patent or the ISO 7810 standard mentions or suggests the storage of biometric/fingerprint data on the third track of the magnetic stripe.

As the Examiner is aware, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim features. The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the Applicant has done. To support the conclusion that the claimed

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invention is directed to obvious subject matter, either the reference must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the reference. Both the suggestion to make the claimed combination and the reasonable expectation of success must be founded in the prior art and not in Applicant's disclosure.

There is simply no teaching or suggestion in the cited references to provide the combination of features as claimed. Accordingly, for at least the reasons given above, Applicant maintains that the cited references do not disclose or fairly suggest the invention as set forth in Claims 1, 8 and 14. Furthermore, no proper modification of the teachings of these references could result in the invention as claimed. Thus, the rejections under 35 U.S.C. §103(a) should be withdrawn.

It is submitted that the independent claims are patentable over the prior art. In view of the patentability of the independent claims, it is submitted that their dependent claims, which recite yet further distinguishing features are also patentable over the cited references for at least the reasons set forth above. Accordingly, these dependent claims require no further discussion herein.

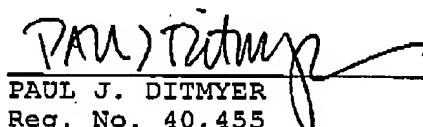
### III. Conclusion

In view of the foregoing remarks, it is respectfully submitted that the present application is in condition for

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allowance. An early notice thereof is earnestly solicited. If, after reviewing this Response, there are any remaining informalities which need to be resolved before the application can be passed to issue, the Examiner is invited and respectfully requested to contact the undersigned by telephone in order to resolve such informalities.

Respectfully submitted,

  
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CERTIFICATE OF FACSIMILE TRANSMISSION

I HEREBY CERTIFY that the foregoing correspondence has been forwarded via facsimile number 703-308-5841 to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 this 14<sup>th</sup> day of January, 2004.

